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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/599,739

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EXAMINER

MACKEY, JAMES P

ART UNIT

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1791

MAIL DATE

DELIVERY MODE

03/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,739	Applicant(s) KONDO ET AL.	
	Examiner James Mackey	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,6 and 7 is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☒ Claim(s) 4,5,8 and 9 is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/6/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted:

Group I, claim(s) 1-9, drawn to a die for manufacturing a core.

Group II, claim(s) 10-11, drawn to a method for manufacturing a core.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the method of Group II does not require the special technical feature of a ring-shaped core die held between first and second transfer-molding dies, or a ring-shaped core die held between a transfer-molding die and a compression-molding die, as required by claims 1 and 6, respectively, of the die of Group I.

During a telephone conversation with Steve Gruskin on 14 March 2008, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-9.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 10 and 11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

Applicant should update the Title to reflect the elected invention, i.e. apparatus only.

Claim Objections

Claims 4, 5 and 9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

It is noted that a Preliminary Amendment has been filed which amends the dependency of several of the claims; however, claim 4 currently depends from “any one of claims 1 to 3claim1” (note no underlining in this phrase), claim 5 currently depends from “any one of claims 1 to ‘I claim 1’” (note no underlining in this phrase, and the typographical “ ’I” is as presented in the Preliminary Amendment), and claim 9 currently depends from “any one of claims 1 to 8claim1” (underlining as shown in the amended claim). In view of the unclear and erroneous claim dependencies of claims 4, 5 and 9, these claims are being treated as improper multiple dependent claims. (Note also that the Preliminary Amendment does not amend multiple dependent claims 3 and 8, even though the Preliminary Amendment sets forth both claims 3 and 8 as "Currently Amended", and even though underlining is present in the unchanged original claim dependency.)

Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 8 does not recite additional structure of the claimed die apparatus, but merely recites how the claimed apparatus is intended to be operated during its intended use; however,

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such relates only to the intended use of the claimed apparatus structure which does not patentably distinguish apparatus structure and therefore does not further limit the subject matter of the apparatus claims. See *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 152 USPQ 235.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, “pod portions” and “pot portions” are used to refer to the same structure, thus rendering the claim indefinite. (Note that “pot portions” is not recited in the disclosure, even though “pot” is typically used in the prior art to refer to the injection chamber of a transfer-molding die.)

Allowable Subject Matter

Claims 1, 2, 6 and 7 are allowed.

Claim 3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The prior art of record does not teach or fairly suggest a die comprising a ring-shaped core die for supporting a ring-shaped preform from radial inner side directions thereof while maintaining a non-contact state with both widthwise direction edge portions of the preform, first and second transfer-molding dies that are disposed to hold the core die therebetween from the core die axial direction and form cavities between the first transfer-molding die and the core die

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as well as between the second transfer-molding die and the core die for respectively forming rubber portions at the both edge portions of the preform, and a transfer part that injects rubber material into runners that are respectively formed at the first and second transfer-molding dies and simultaneously transfers the rubber material into the cavities for molding and vulcanizing thereof, as claimed in claim 1. The prior art of record does not teach or fairly suggest a die comprising a ring-shaped core die for supporting a ring-shaped preform from radial inner side directions thereof while maintaining a non-contact state with both widthwise direction edge portions of the preform, a transfer-molding die and a compression-molding die that are disposed to hold the core die therebetween from the core die axial direction and form cavities between the transfer-molding die and the core die as well as between the compression-molding die and the core die for respectively forming rubber portions at the both edge portions of the preform, and a transfer part that, concurrently with rubber material being compressed in the compression-molding die, injects rubber material into runners that are formed at the transfer-molding die and transfers the rubber material into the cavities for molding and vulcanizing thereof, as claimed in claim 6.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Mackey/
Primary Examiner
Art Unit 1791

jpm
March 17, 2008